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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,200	08/22/2001	Roger C. Palmer	077056-0353	8757

7590 02/01/2005
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EXAMINER

TRAN, HENRY N

ART UNIT	PAPER NUMBER
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2674

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/935,200

Applicant(s)

PALMER ET AL.

Examiner

HENRY N TRAN

Art Unit

2674

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

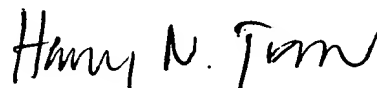
The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 7,18,20,21 and 27.Claim(s) rejected: 1-6,8-17,19 and 22-26.

Claim(s) withdrawn from consideration: _____.

8. ☒ The drawing correction filed on 22 August 2001 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____



HENRY N TRAN
Primary Examiner
Art Unit: 2674

Continuation of 5. does NOT place the application in condition for allowance because: of the rejection recited in the final Office action mailed 9/16/04.

Applicant's arguments filed 11/19/04 have been fully considered but they are not persuasive because of the following reasons.

Re claims 1, 8, and 23, Fenton et al (U.S. Patent No. 6,343,264) does teach: "the color selection process can be applied to any floor, window and wall coverings and other products ..." (see col. 2, lines 37-40), which is read on "physically applying the decorative element according to ..." as recited in the newly amended claims 1 and 8. Ring et al (U.S. Patent No. 5,754,184) teaches the use of a printer 26 for physically printing "color hard copy" from a selected color image modified by the operator (see figs. 1 and 7; col. 5, lines 25-31). Accordingly, Claims 1, 8 and 23 stand rejected. It's noted that claims 1 and 8 do not recite the step of "printing".

Re the amended claims 18, 20 and 21, which are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because they recite the limitations: "the selected decorative element". There is insufficient antecedent basis for this limitation in the claim.

Applicant argued that "The customer will leave the retail outlet with actual, physical window coverings having a chosen decorative element applied thereto", technique for "applying" the decorative element to the window covering comprising at least one of printing, laminating, and texturing, which are described in the Specification. In response to applicant's argument that the references fail to show such a "applying" technique, it is noted that the techniques upon which applicant relies are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Upon reviewing the disclosure, the examiner would like to remind applicant that the claimed terms "window covering", "Imaging" or "printing" are intended to be broad terms and not terms of limitation; see Specification, paragraphs 38 and 39. Applicant is allowed to choose his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure, see MPEP § 2111.01. The claims are given their broadest reasonable interpretation consistent with the specification. Claims 16-17, 19 and 22-26 stand rejected as discussed in the prior Office action because of the rejections recited in the prior Office action. Clearly, "physically applying", as recited in the claim languages, does not mean "printing", or "laminating", or "texturing" as argued by the applicant.

Note: Reference numbers: 28, 30, 32 (para. 24), 65, 67 (para. 29), and 70 (para. 70) described in the Specification have not been illustrated in the drawings.

Henry N. Tran 
Primary Examiner

1/31/05